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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,961	03/22/2001	Stefan Prange	112740-194	1231

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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/787,961	<b>Applicant(s)</b> PRANGE ET AL.	
	<b>Examiner</b> John M. Winter	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-30, 32-37, 39, 40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37, 39, 40 and 42 is/are allowed.
- 6) ☒ Claim(s) 22-30 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Claims 22-30, 32-37,39-40, 42 remain pending.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Response to Arguments*

The Applicants arguments filed on June 10, 2006 have been fully considered.

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.

The Applicant states that it would not be obvious to additionally transmit acknowledgement/confirmation data with respect to a particular transaction.

The examiner responds that it is well known and obvious in the art to employ multiple layers of security when processing digital transactions, it is a well established practice to encapsulate a digital message within a secondary digital "wrapper" where both the message and the wrapper are independantly validated.

The examiner states that the phrase "electromagnetic waves" does not inherently imply the communication is "wireless" it is obvious and well known that many types of cable serve as waveguides for the transmission of electromagnetic signals (e.g. co-axial cable, phone wire etc...)

The examiner states that Albert et al. discloses "encrypting and converting the signals received by said phone line interface to a second signal format different from the first signal format and incompatible with the public switched phone system thereby producing a encrypted data in the second signal format indicative of a financial transaction," (column 18, lines 49-54) the examiner contents that this procedure along with the previously stated procedure of sending financial data to a financial institution's network address are analagous to the claimed feature of "writing at least some of the data required for payment to a short message memory of a mobile

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radio device as a readable short message, a sender telephone number entered being the telephone number of a telecommunication device of one of a financial institution and a bill issuer”

See following rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (US Patent No 6,442,532) in view of Terranova (US Patent 6,098,879) and further view of Rosen. (US Patent 5,953,423) and further view of Albert et al. (US Patent 5,991,410).

As per claim 22,

Kawan ('532) discloses a method for paying for goods and services using both a mobile radio device and a base telecommunication station which communicates with the mobile radio device via electromagnetic waves, the method comprising the steps of:

transmitting data required for payment from the base telecommunication station to the mobile radio device;(Column 5, lines 13-21)

asking a user, at the mobile radio device, for confirmation for the payment;(Column 8, lines 28-30, column 6, lines 7-15)

Kawan ('532) does not explicitly disclose initiating a payment operation, via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer. Terranova ('879) discloses initiating a payment operation, via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer. (Column 31, lines 23-29). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

Kawan ('532) does not explicitly disclose transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer. Rosen. ('423) discloses transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer(Figure 15A). It would be obvious to one having ordinary skill in the art at the time the

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invention was made to combine the Kawan ('532) method with the Rosen. ('423) method in order to allow the transaction to be processed by an online banking system.

Kawan ('532) does not explicitly disclose writing at least some of the data required for payment to a short message memory of a mobile radio device as a readable short message, a sender telephone number entered being the telephone number of a telecommunication device of one of a financial institution and a bill issuer. Albert et al. ('410) discloses writing at least some of the data required for payment to a short message memory of a mobile radio device as a readable short message, a sender telephone number entered being the telephone number of a telecommunication device of one of a financial institution and a bill issuer (Column 17, lines 43-54, Figure 3 [although Albert et al. does not specifically disclose the telephone number of a financial institution the examiner contends that the network address of the banking institutions wireless network is analogous to the phone number of a banking institution utilizing a SMS system]). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Albert et al. ('410) method in order to allow the transaction to be processed by an online banking system.

As per claim 23,

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

wherein the step of initiating a payment of operation includes the mobile radio device communicating directly with a telecommunication device of a financial institution.(Column 4, lines 53-60).

As per claim 24

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

herein the step of initiating a payment operation includes the mobile radio device transmitting the payment instruction data to the base telecommunication station, and the base telecommunication station transmitting the payment instruction data to a telecommunication device of a financial institution via a landline network connection.(Column 3, lines 13-26)

As per claim 25

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, the method further comprising the step of:

converting, via the mobile radio device, the data received from the base telecommunication station into a format which is suitable for a payment operation before transmission.(Column 3, lines 34-37)

As per claim 26

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, the method further comprising the step of:

authenticating the user of the mobile radio device before the step of initiating the payment operation.(Column 8, lines 61-66)

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As per claim 27

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 26,

wherein the user is authenticated via at least one of a personal identification number entry and biometric features.(Column 8, lines 61-66; column 9, lines 1-3)

As per claim 28

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

wherein an electronic cash register transmits the data required for payment to the base telecommunication station.

As per claim 29

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22.

Kawan ('532) does not explicitly disclose transmitting, via the base telecommunication station, a key generated in one of the base telecommunication station and an associated unit to the mobile radio device; transmitting the key, via the mobile radio device, to the telecommunication device of one of a financial institution and a bill issuer. Terranova ('879) discloses transmitting, via the base telecommunication station, a key generated in one of the base telecommunication station and an associated unit to the mobile radio device; transmitting the key, via the mobile radio device, to the telecommunication device of one of a financial institution and a bill issuer.(Column 31, lines 55-67; column 32, lines 1-9). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity by authenticating the user.

Official Notice is taken that "transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer" is common and well known in prior art in reference to wireless transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer because this allows authentication of the user.

As per claim 30

Kawan ('532) discloses a method for paying for goods and services as claimed in

Kawan ('532) does not explicitly disclose the key is used at least on particular transmission paths to encrypt data which is to be transmitted. Terranova ('879) discloses the key is used at least on particular transmission paths to encrypt data which is to be transmitted(Column 30, lines 39-44). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity.

As per claim 32

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Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

Kawan ('532) does not explicitly disclose transmitting a short message containing data required for payment to the telecommunication device of one of the financial institution and the bill issuer after the short message has been read and after appropriate confirmation by the user. Albert et al. ('410) discloses transmitting a short message containing data required for payment to the telecommunication device of one of the financial institution and the bill issuer after the short message has been read and after appropriate confirmation by the user (Column 17, lines 43-54, Figure 3 [although Albert et al. does not specifically disclose the telephone number of a financial institution the examiner contends that the network address of the banking institutions wireless network is analogous to the phone number of a banking institution utilizing a SMS system]). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Albert et al. ('410) method in order to allow the transaction to be processed by an online banking system.

Kawan ('532) does not explicitly disclose the feature of "automatically transmitting " the examiners contends that the mere automation of a process does not establish novelty (*In re Venner*, 120 USPQ 192,194)

As per claim 33

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

Kawan ('532) does not explicitly disclose the mobile radio device and the telecommunication device of one of a financial institution and a bill issuer communicate on the basis of a mobile radio standard. Terranova ('879) discloses the mobile radio device and the telecommunication device of one of a financial institution and a bill issuer communicate on the basis of a mobile radio standard.(Column 31, lines 9-25). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to promote interoperability of commercial systems.

As per claim 34

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 29.

Kawan ('532) does not explicitly disclose comparing the transmitted key with a key stored in one of the base telecommunication station and an associated unit; and providing at least one of goods and services upon a successful comparison between the transmitted key and the key stored. Terranova ('879) discloses comparing the transmitted key with a key stored in one of the base telecommunication station and an associated unit; and providing at least one of goods and services upon a successful comparison between the transmitted key and the key stored. (Column 31, lines 9-25). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

As per claim 35

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Kawan ('532) discloses a method for paying for goods and services as claimed in claim 29.

Official Notice is taken that "the key is transmitted together with at least one of data required for the payment operation and acknowledgement data for the payment operation." is common and well known in prior art in reference to wireless transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer because this allows authentication of the user.

As per claim 36

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

wherein the data required for payment includes at least one of a sum of money which is to be paid, a name for the goods to be paid for, a name for the service to be paid for, a recipients account number, a bank sort code, a purpose of use, a customer (Column 6, lines 39-57).

### ***Allowable Subject Matter***

Claim 37, 39-40 and 42 are allowable over the prior art record.

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**



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**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW

August 15, 2006

**JAMES A. REAGAN  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'J. Reagan', is written over the printed name and title.